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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,398	01/27/2000	Al J. Mooney		9822

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 04/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/492,398

Applicant(s)

MOONEY, AL J.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 32-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**SAM RIMELL**  
**PRIMARY EXAMINER**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 32-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Silver ('339).

Claim 32: FIG. 22 describes a website on the Internet (col. 8, lines 15-17). The website is established by a medical care provider (Dr. Michael Roizen, as seen in FIG. 2). The purpose of the website is twofold: (1) For facilitating a medical examination in the form of a health profile questionnaire (col. 9, line 42) presented to the user; and (2) For prescribing specific medical supplies that can be ordered by a user (col. 18, lines 55-68).

Once the medical examination (questionnaire) has been completed, the interface of FIG. 22 is presented, illustrating the conclusions of the medical examination. The user can then check a box (indicated by the check mark) which will produce a report indicating a URL for a medical supply vendor (col. 18, lines 61-63). The user can then redirect his/her computer to that supply vendor using the URL as the guide for locating the supply vendor's site. The user can then consummate a transaction with the medical supply vendor through the vendor's website or by

placing a toll free telephone call. The e-commerce provider can be any server computer on the Internet, including the server which supports the website described by Silver (col. 7, line 61), or server computers that support the medical supply vendor.

The medical care provider receives payment (compensation) through subscriptions for the service of providing the questionnaire and prescriptions resulting from the questionnaire.

Claim 33: The examination is the questionnaire provided to the user and the diagnosis is the automated analysis performed which leads to the set of recommendations in FIG. 22. The recommendations of FIG. 22 become the prescription which the medical care provider orders for the patient.

Claim 34-35: The e-commerce providers are servers on the Internet which either support the website of Silver or the medical supply vendor (servers are described at col. 7, line 61 and are also inherent features of the Internet.). In Silver, the servers which support the website pass payments to the medical care provider (See block 112 in FIG. 1). Servers which support the medical supply vendor could inherently pass payments as well.

Claim 36: Given that the disclosure of Silver calls for a medical care provider and a medical supply vendor, each of which are paid for what they provide, it is inherent that each have an account to receive payments.

Claim 37: The website of Silver permits a user to gain access to medical supplies that correlate to a specific prescription for that user (col. 18, lines 55-57). The medical care provider acts as a participant in the sale by making a referral to the supply vendor.

Claim 38: A server which supports a website on the Internet can be considered a network gateway.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-49 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claims 39-49: 35 USC 101 establishes that a claimed invention is found to lack utility if the content of the claimed invention is found to contradict public policy (also see MPEP 706.03(a), under the subheading "Utility"). Claim 39 in particular calls for the step of paying the doctor a fee which is based upon the sale of a medical supply sold by a vendor to a patient. This claim is addressed to the specific embodiment described in the applicant's specification on page 7, lines 17-20, where a vendor directs a referral fee to a doctor upon the purchase of supplies from the vendor by the patient.

The receipt of referral fees by physicians in return for arranging the purchase of goods or services that may be covered by a Federal Health Program is a practice which is barred by Federal law. In particular Title 42, Section 1320a-7b of the United States Code prohibits physicians from receiving rebates or fees "...in return for purchasing, leasing, ordering or arranging for or recommending purchasing, leasing, or ordering any good, facility, service, or item for which payment may be made in whole or in part under a Federal Health Program". See the reference cited with this office action entitled "US Code Collection, page 3, section (b)(1)(B).

Since the claims are addressed to the purchase of products which could be covered by a Federal Health program (i.e. products covered by Social Security or Medicare) and since the steps of remitting a referral fee for arranging or recommending the purchase of goods is

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explicitly prohibited by law, claims 39-49 appear to be addressed to a method which violates a specific public policy. The public policy in this instance is a specific Federal law. Accordingly, claims 39-49 are found to lack utility under 35 USC 101 for presenting a method which contradicts public policy.

Remarks

Applicant's arguments are addressed primarily to the Silver reference (U.S. Patent 6,269,339) which was previously cited in the Final rejection of October 16, 2002. In particular, applicant argues that the transaction set forth in claim 32 cannot be equated to the payment of subscription fees. However, claim 32 only requires that the medical provider receives, directly or indirectly, compensation for the transaction. Since the payment of subscription fees is compensation that leads to a transaction, the claim limitations appear to be met by the reference to Silver.

This office action is not made final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell  
Primary Examiner  
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